

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 336625899US, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: 11/19/03

Signature: Tia E. Zimmerman  
(Tia E. Zimmerman)

Docket No.: 226272007801  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Haifeng CHEN et al.

Application No.: 10/089,394

Group Art Unit: 1636

Filed: March 29, 2002

Examiner: M. Marvich

For: PRODUCTION OF RECOMBINANT AAV  
USING ADENOVIRUS COMPRISING AAV  
REP/CAP GENES

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Restriction Requirement dated October 24, 2003 for which a response is due on November 24, 2003. Therefore, this response is timely filed.

The Examiner requires restriction to one of the following inventions:

Group I, claims 1-18 and 24, drawn to an adenovirus vector for the manufacture of rAAV (recombinant AAV) comprising the AAV rep gene wherein the AAV p5 promoter is deleted upstream of the rep gene and methods of producing rAAV using the adenovirus vector.

Group II, claims 19-21, drawn to a lysate and purified comprising rAAV produced by the method of Group I.

Group III, claims 22-23, drawn to methods for transient or stable gene transfer using the rAAV of Group II.

Applicants traverse this restriction requirement and respectfully request reconsideration based upon the following comments.

The International Searching Authority initially determined that two inventions were claimed: invention 1, claims 1-18 and 24; and invention 2, claims 19-23. The International Preliminary Examining Authority indicated in the Written Opinion mailed September 21, 2001 (copy attached) that all inventions were examined since the second invention could be examined without effort justifying an additional fee.

The USPTO Examiner has required restriction from among 3 groups in spite of an International Search Authority indicating that there are only two groups and an International Examining Authority stating that *all* claims could be examined *without effort justifying an additional fee*. Applicants traverse this restriction requirement and submit that there is no search burden to the USPTO Examiner in searching all groups together.

Applicants elect Group I, claims 1-18 and 24, with traverse. Applicants request rejoinder of methods claims to the extent they depend from or include all the limitations of allowable product claims. See *In re Ochiai*.

In addition, Applicants respectfully invite the Examiner's attention to what appears to be an error in recitation of "Group I-V" at the bottom of page 2. Applicants believe the Examiner intended to recite "Groups I-III".

In the unlikely event that the transmittal form is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing 226272007801. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: November 19, 2003

Respectfully submitted,

By   
Debra J. Glaister

Registration No.: 33,888  
MORRISON & FOERSTER LLP  
755 Page Mill Road  
Palo Alto, California 94304

(650) 813-5725



11-21-03

GAU-1636

PTO/SB/21 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/089,394	
	Filing Date	March 29, 2002	
	First Named Inventor	Haifeng CHEN	
	Art Unit	1636	
	Examiner Name	M. Marvich	
Total Number of Pages in This Submission	11	Attorney Docket Number	226272007801

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): 1. Response to Restriction Requirement (3 pages) 2. Copy of PCT Written Opinion (7 pages) 3. Return Receipt Postcard
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual name	MORRISON & FOERSTER LLP Debra J. Glaister - 33,888	25226
Signature		
Date	November 19, 2003	

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 336625899US, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: 11/19/03 Signature: (Tia B. Zimmerman)